

Applicant : Ludwig et al.  
Serial No. : 10/551,020  
Filed : May 30, 2006  
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Attorney's Docket No.: 02894-723US1 / 06768-PT22/rr

Amendments to the Drawings:

The attached replacement sheet of drawings includes changes to Fig. 1 and replaces the original sheet including Figs. 1 and 2.

In Figure 1, a turning device 31 has been added.

Attachments following last page of this Amendment:

Replacement Sheet (1 page)  
Annotated Sheet Showing Change(s) (1 page)

## REMARKS

### *The Specification*

The Examiner requests that the specification be corrected to delete the reference to the claims. Applicants respectfully note that this correction was made in Applicants' response submitted January 2, 2007.

### *The Drawings*

The Examiner has maintained the objection to Applicants' drawings, stating that "the adjustability feature of the guiding surface of claim 5 and the turning device for flow element 12 of claim 10 must be shown." Applicants respectfully submit that a drawing showing details of these features is not necessary. Each of these features is in itself conventional, and a detailed drawing is not essential for a proper understanding of the invention. With respect to the device for moving (not necessarily turning) the plates of flow element 12, as is appropriate this device has been added to Fig. 1 in the form of labeled representation (e.g., a labeled rectangular box). See 37 C.F.R. 1.83. With respect to the adjustability feature of the guiding element, Applicants respectfully submit that the guiding element shown in Fig. 1 is described in Applicants' specification as an adjustable flow element, e.g., a honeycomb or lamellar element, and is shown diagrammatically as such. Adjustable lamellar elements are well known in the art (see, e.g., the swiveling lamellae 21 disclosed in U.S. Patent No. 6,179,707) and thus a detailed drawing is not necessary.

### *Claim Rejections under 35 U.S.C. §112, First Paragraph*

Claims 1-10, 12-14, 22, and 23 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner contends that "in the independent claims the device which turns one plate relative to the other is not adequately provided." The Examiner also contends, with regard to claim 5, that "there is not detail as to how the guiding element is adjustable," and, with regard to claim 10, that "there is no turning

device shown on the drawings (for the first flow element 12)." These rejections are respectfully traversed.

35 U.S.C. § 112, first paragraph provides in relevant part:

"The specification shall contain a written description of the invention, ..."

The policy behind the written description requirement is to ensure that the invention covered by the later filed claims was "something [the inventors] actually invented." See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991) (quoting *In re Ruschig*, 379 F.2d 990, 995-96 (C.C.P.A. 1967)). In other words, an inventor should be able to claim only the invention (or inventions) actually described in the application as filed to avoid allowing the inventor to later claim a different invention.

The general legal standard for determining whether the written description requirement is met is well-established. As the Court of Appeals for the Federal Circuit (CAFC) recently discussed in *Purdue Pharma v. Faulding, Inc.*, 230 F.3d 1320, 1323 (2000) (emphasis added):

[T]he disclosure must ... convey with reasonable clarity to those skilled in the art that ... [the inventor] was in possession of the invention. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Put another way, one skilled in the art, reading the original disclosure, must immediately discern the limitation at issue in the claims. *Waldemar Link GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558 31 USPQ2d 1855, 1857 (Fed. Cir. 1994).

Applicants' specification as filed clearly discloses the claim elements in question. In fact, the claim language in question corresponds almost verbatim to the wording of Applicants' specification at page 7, second paragraph. (The language "co-acting," which was suggested by Exr. Dillon, has been removed herein, as it is not necessary to patentability and does not appear in Applicants' specification.) Moreover, with respect to claim 5, Applicants note that the adjustability of the guiding element (flow element 16) was recited in Applicants' claims as originally filed. Accordingly, there is no doubt that the person of skill in the art, reading Applicants' original disclosure, would immediately discern the claim limitations at issue.

As such, the skilled artisan would reasonably conclude that Applicants were indeed in possession of the invention as recited in Applicants' pending claims. Applicants submit that 35 U.S.C. § 112, ¶1 is therefore satisfied with respect to every limitation recited in the present claims.

Applicants note that, while the Examiner has not rejected the claims for lack of enablement, the Examiner seems to be raising issues regarding enablement. These concerns are misplaced.

The turning devices and the adjustable guiding element are not in themselves the Applicants' inventive contribution. These elements were not, and need not be, described in detail because they are not in themselves new. For example, an airflow device for a heating/cooling system that includes perforated plates that turn relative to each other is disclosed in U.S. Patent No. 5,120,274. Other methods of turning one plate relative to another are well known, and would be well known to the person of ordinary skill in the art. Adjustable flow elements in the form of a honeycomb or lamellar element, as disclosed in Applicants' specification at page 7, paragraph one, are also well known to those of ordinary skill in the art.

**Claim Rejections under 35 U.S.C. §102(b)**

The Examiner has rejected claims 1-5 and 7-9 as being anticipated by Ingraham et al. The Examiner indicates, in the marked-up drawing attached to the Office Action, the Ingraham's element 64 is being construed as a turning device. This interpretation is not supported by -- and is in fact entirely inconsistent with -- the text of the Ingraham reference. Ingraham clearly states that plates 54 and 56 slide transversely relative to each other (col. 7, lines 14-16). This transverse sliding movement is effectuated by a slide assembly which includes the bar 64 indicated by the Examiner to be a "turning device."

Moreover, in order to further distinguish the Ingraham device, Applicants have amended the independent claims to recite that the first flow element also comprises two perforated plates. The Ingraham device does not include a second pair of perforated plates, and thus Applicants' claims as amended are clearly not anticipated by Ingraham for this reason as well.

It is also noted that Ingraham's chamber 4, which the Examiner considers as a first flow element, is not configured to uniformly distribute the air current over the sliding surface as required by Applicants' claims. The air current reaching what the Examiner considers the second flow element is clearly not uniformly distributed due to the turbulence created in the chamber.

Finally, Ingraham does not teach or remotely suggest applying a first air current to the work pieces *to orient the work pieces in a predetermined orientation direction* along a sliding surface as required by claim 12. Ingraham is completely silent with regard to his device performing any type of orientation function. According to Ingraham, work pieces are only *transported* and nothing more. It was the Applicants who first recognized that the claimed combination of first and second flow elements and a guiding element is necessary to enable work pieces to be oriented by air flow.

Applicants respectfully submit that this rejection is improper for at least the reasons explained above, and request that it be withdrawn.

### Conclusion

Applicants submit that all claims are in condition for allowance.

Please apply the Petition for Extension of Time fee, and any other charges or credits, to deposit account 06-1050 referencing Attorney Docket No. 02894-723US1.

Respectfully submitted,

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